

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of : JONES et al.
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Group Art Unit : 2617
Examiner : David Nguyen

**APPEAL BRIEF
On Appeal from Group Art Unit 2617**

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By: Brian S. Myers
Brian S. Myers
Attorney for Appellant
Reg. No. 46,947
For: Larry Liberchuk,
Reg. No. 40,352
Senior IP Counsel
Philips Electronics N.A. Corporation
914-333-9602

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I. REAL PARTY IN INTEREST

The real party in interest is Koninklijke Philips Electronics N.V., the assignee of record.

II. RELATED APPEALS AND INTERFERENCES

Appellant is not aware of any pending appeals, judicial proceedings, or interferences which may be related to, directly affect, be directly affected by, or have a bearing on the Board's decision in the pending appeal.

III. STATUS OF CLAIMS

- a) Claims 20-36 are pending.
- b) Claims 20-36 stand rejected and are the subject of this appeal.
- c) Claims 20, 23 and 25 are independent.

IV. STATUS OF AMENDMENTS

The claims listed in section "VIII. Claims Appendix" of this Appeal Brief correspond to the claims as amended and submitted in Appellant's response of February 13, 2007. These amendments were entered by the Examiner. No claim amendments have been submitted following the response of February 13, 2007. Nor are any claim amendments pending.

V. SUMMARY OF CLAIMED SUBJECT MATTER

The claimed invention, as recited in claim 20, is directed to a communication device. The communication device comprising: a receiver (fig. 1, 30, 32, 34; page 3, lines 12-30) operable to receive an incoming message that does not include a predetermined tone or melody

(page 4, lines 7-12, page 6, lines 20-22, and page 8, line 32 to page 9, line 10); and a processor (fig. 1, 36; page 3, lines 12-30) in communication with the receiver and operable to compose a melody corresponding to the incoming message (Figs. 2 & 3; page 4, line 20 to page 9, line 21).

The claimed invention, as recited in claim 23, is directed to a method of operating a communication device in alerting a user of the communication device of an incoming message. Said method comprising: receiving the incoming message that does not include a predetermined tone or melody (page 4, lines 7-12, page 6, lines 20-22, and page 8, line 32 to page 9, line 10); and composing a melody corresponding to the incoming message subsequent to a reception of the incoming message (Figs. 2 & 3; page 4, line 20 to page 9, line 21).

The claimed invention, as recited in claim 25, is directed to a communication device, comprising: a receiver (fig. 1, 30, 32, 34; page 3, lines 12-30) operable to receive an incoming message that does not include a predetermined tone or melody (page 4, lines 7-12, page 6, lines 20-22, and page 8, line 32 to page 9, line 10); and a processor (fig. 1, 36; page 3, lines 12-30) in communication with the receiver and operable to control a display (page 3, lines 18-20) of the incoming message and to compose a melody corresponding to the incoming message (Figs. 2 & 3; page 4, line 20 to page 9, line 21).

VI. GROUNDS OF REJECTION TO BE REVIEWED ON APPEAL

Whether claims 20, 23 and 25 are properly rejected under 35 U.S.C. 112, first paragraph, as failing to enable the claimed invention.

Whether claims 20-29, 31-32 and 34-35 are properly rejected under 35 U.S.C. 102(e) as being anticipated by Morishima (US 6075998).

Whether claims 30, 33, and 36 are properly rejected under 35 USC 103(a) as being unpatentable over Morishima in view of Willner et al. (US6064666) (hereinafter Willner).

VII. ARGUMENT

Appellant respectfully traverses the rejections in accordance with the detailed arguments set forth below.

A. Claims 20, 23 and 25 are not properly rejected under 35 U.S.C. 112, first paragraph, as failing to enable the claimed invention.

The Examiner indicates that the specification does not enable one skilled in the art to compose a melody corresponding to an incoming message that does not include a predetermined tone or melody (final Office Action, page 2). The Examiner points to page 4, lines 13-26 of Appellant's specification, which states the digits could represent a canned message.

Appellant respectfully submits the specification clearly supports the features recited in claims 20, 23 and 25.

Turning first to page 4, lines 13-26, the specification provides several examples of an incoming message. As stated in the specification, an incoming paging message is described for convenience of explanation. The specification describes that a paging message typically includes a set of numerals representing a telephone number, which the receiver of the page should call; or the numerals, rather than a telephone number, could represent to the receiver a "canned message" that is some pre-stored message associated with the received set of numerals.

The examples in this paragraph are describing some typical contents of a received page. Nowhere does this paragraph state that an incoming message must include a predetermined tone or melody. This paragraph simply provides examples of receiving a numeric page and what the

numerals could represent. As described on page 8, line 32 to page 9, line 10, the message could also be an alphanumeric message.

The Examiner states in paragraph 1 of the Office Action that the “canned message” is considered as the message “[[“ representing a melody message.

It appears that the Examiner is arguing what is shown in the cited prior art Morishima. It is unclear why the Examiner is arguing what appears in Morishima to support this 112, first paragraph rejection. Even if the “canned message” is considered as a message representing a melody message, the “canned message” may just as well not be a melody message and as claimed be an incoming message that does not include a predetermined tone or melody. Another example may be an incoming page with a telephone number to be called, where there is no melody message included.

Clearly, Appellant’s specification supports the claimed invention. The specification teaches receiving an incoming page, for example, a page having a set of numerals. The numeral could represent a phone number to call or a canned message or any other message (page 4, lines 13-19 and page 8, line 32 to page 9, line 10). However, the claims recite that the incoming message does not include a predetermined tone or melody.

Upon receiving the paging message, a processor composes a melody corresponding to the incoming message. For example, the incoming message is a phone number, the processor composes a melody based on the digits in the phone number. The specification supports this feature starting at page 4, line 20 through page 9. See also Fig. 2 and 3. As claimed, the digits in the phone number would not include a predetermined tone or melody.

As specifically described in the Appellant's specification, page 6, lines 16-23, the melodies are generated from the numeric and/or alphanumeric data in incoming messages. That is incoming messages that do not include a predetermined tone or melody.

For at least the foregoing reasons it is respectfully submitted that the claimed invention is supported by the specification and the rejection should be reversed.

B. Claims 20-29, 31-32 and 34-35 are not properly rejected under 35 U.S.C. 102(e) as being anticipated by Morishima (US 6075998).

To anticipate the claimed invention the cited reference must teach each and every claimed feature.

1. Claim 20

Appellant's independent claim 20 includes features not found or even suggested in the cited reference Morishima. For example, claim 20 recites: "a receiver operable to receive an incoming message that does not include a predetermined tone or melody; and a processor in communication with the receiver and operable to compose a melody corresponding to the incoming message" (emphasis added).

In paragraph 3 of the final Office Action the Examiner points to col. 6, lines 18-41 of Morishima as describing the claimed features.

However, Morishima clearly describes that the incoming message includes the melody or musical information. Morishima, col. 6, lines 2-11, teaches that the numeral data D2 through D4 of the message specify musical tone information and musical note information data.

In the section of Morishima pointed to by the Examiner, Col. 6, lines 18-41, Morishima again teaches the message includes musical information. This section states: "the CPU 5

recognizes]] in the numeral data D1 of the message information supplied from the decoder circuit 3, the CPU 5 recognizes that the identification symbol]] for the melody announcement has been received.”

Also in the same section of Morishima: “the CPU 5 recognizes the numeral data D2 through D3 ... following the identification symbol]] as the musical tone information indicated by pairs of two numerals” Thus, Morishima teaches a predetermined tone or melody is included in the message.

For at least the foregoing reasons, Morishima fails to teach or suggest the features recited in Appellant’s claim 20; thus, the claim cannot be anticipated and the rejection should be reversed.

2. Claim 23

Appellant’s independent claim 23 includes features not found or even suggested in the cited reference Morishima. For example, claim 23 recites: “receiving the incoming message that does not include a predetermined tone or melody; and composing a melody corresponding to the incoming message subsequent to a reception of the incoming message” (emphasis added).

The Examiner rejects claim 23 using nearly identical arguments as used to reject claim 20 (see final Office Action, page 3). As pointed out above, with regard to claim 20, Morishima fails to teach at least the features of claim 23 including receiving an incoming message that does not include a predetermined tone or melody and composing a melody corresponding to the incoming message. Appellant essentially repeats the above arguments from claim 20 pointing out why claim 23 cannot be anticipated by Morishima.

Thus, for at least the foregoing reasons, Appellant respectfully submits that independent claim 23 is not anticipated by Morishima and the rejection should be reversed.

3. Claim 25

Appellant's independent claim 25 includes features not found or even suggested in the cited reference Morishima. For example, claim 25 recites: "receive an incoming message that does not include a predetermined tone or melody;" and "to compose a melody corresponding to the incoming message" (emphasis added).

The Examiner rejects claim 25 using nearly identical arguments as used to reject claim 20 (see final Office Action, page 3). As pointed out above, with regard to claim 20, Morishima fails to teach at least the features of claim 25 including an incoming message that does not include a predetermined tone or melody and to compose a melody corresponding to the incoming message. Appellant essentially repeats the above arguments from claim 20 pointing out why claim 23 cannot be anticipated by Morishima.

Thus, for at least the foregoing reasons, Appellant respectfully submits that independent claim 25 is not anticipated by Morishima and the rejection should be reversed.

4. Dependent Claims 21-22, 24, 26-29, 31-32 and 34-35

Claims 21-22 and 31-32 depend from independent claim 20 and include at least the distinguishing feature found in claim 20 as pointed out above. Claims 24 and 34-35 depend from independent claim 23 and include at least the distinguishing feature found in claim 23 and claims 26-29 depend from independent claim 25 and include at least the distinguishing feature found in claim 25.

In rejecting the dependent claims, the Examiner points to the same section of Morishima as discussed above and further to cols. 4 and 5. However, cols. 4 and 5 of Morishima, like col. 6, fail to teach or suggest at least the features of the independent claims as discussed above.

Accordingly, dependent claims 21-22, 24, 26-29, 31-32 and 34-35 are also allowable by virtue of their dependency, as well as the additional subject matter recited therein and the rejections should be reversed.

C. Claims 30, 33 and 36 are not properly rejected under 35 USC 103(a) as being obvious over Morishima in view of Willner.

1. Dependent claims 30, 33 and 36

It is respectfully submitted that to establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art and not based on applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991). See MPEP § 2143-§2143.03 for decisions pertinent to each of these criteria.

Analyzing the references according to the above roadmap, first the Examiner offered an unsupported, conclusory remark for the motivation, that "one of ordinary skill in the art ..." on page 4 of the OA. Morishima teaches specific musical information included in a message. Willner simply teaches converting a voice mail message to text. There is absolutely no motivation or suggestion to combine the references, except on the basis of the impermissible hindsight and knowledge gleaned from Appellant's invention. Neither reference suggests the proposed combination, nor would such a combination be obvious to one skilled in the art.

Second, there is no reasonable expectation of success because the prior art references are not combinable because Morishima and Willner each teach differing systems and one skilled in the art would not have any reasonable expectation of successfully modifying the references as suggested by the Examiner.

Third, Morishima and Willner, even when combined, do not teach or even suggest all of Appellant's features as recited in each of the respective independent claim. See the above discussion of claim 20, for example. As argued above, Appellant's features are not taught or suggested in the prior art references, and their combination is deficient in teaching or suggesting all the claim limitations.

Therefore, the cited combination of references fail to render obvious the claimed invention, because the above-identified criteria are not met. The claimed invention, according to dependent claims 30, 33 and 36, are thus distinguishable over the cited combination of references and the rejections should be reversed.

CONCLUSION

In light of the above, Appellant respectfully submits that the rejections of claims 20-36 are in error, legally and factually, and must be reversed.

Respectfully submitted,

Date: August 21, 2007

By: Brian S. Myers

Brian S. Myers

Attorney for Appellant

Reg. No. 46,947

For: Larry Liberchuk,

Reg. No. 40,352

Senior IP Counsel

Philips Electronics N.A. Corporation

Please direct all future correspondence to:

Larry Liberchuk, Esq.

Senior IP Counsel

Philips Intellectual Property & Standards

P.O. Box 3001

Briarcliff Manor, NY 10510-8001

Phone: (914) 333-9602

Fax: (914) 332-0615

Email: larry.liberchuk@philips.com

VIII. CLAIMS APPENDIX

1 - 19. (Cancelled)

20.(previously presented): A communication device, comprising:

a receiver operable to receive an incoming message that does not include a predetermined tone or melody; and

a processor in communication with the receiver and operable to compose a melody corresponding to the incoming message.

21.(previously presented): The communication device of claim 20, wherein said processor is further operable to divide the incoming message into a plurality of fields to thereby compose the melody.

22.(previously presented): The communication device of claim 21, wherein the plurality of fields includes a tempo field, a repetitive play field, and at least one note field.

23.(previously presented): A method of operating a communication device in alerting a user of the communication device of an incoming message, said method comprising:

receiving the incoming message that does not include a predetermined tone or melody;
and

composing a melody corresponding to the incoming message subsequent to a reception of the incoming message.

24.(previously presented): The communication device of claim 23, further comprising dividing the incoming message into a plurality of fields to thereby compose the melody.

25.(previously presented): A communication device, comprising:

a receiver operable to receive an incoming message that does not include a predetermined tone or melody; and

a processor in communication with the receiver and operable to control a display of the incoming message and to compose a melody corresponding to the incoming message.

26.(previously presented): The communication device of claim 25, wherein said processor is further operable to divide the incoming message into a plurality of fields to thereby transform the message into the melody.

27.(previously presented): The communication device of claim 26, wherein the plurality of fields includes a tempo field, a repetitive play field, and at least one note field.

28.(previously presented): The communication device of claim 25, wherein the incoming message is a numeric message.

29.(previously presented): The communication device of claim 25, wherein the incoming message is an alphanumeric message.

30.(previously presented): The communication device of claim 25, wherein the incoming message is a voice mail message.

31.(previously presented): The communication device of claim 20, wherein the incoming message is a numeric message.

32.(previously presented): The communication device of claim 20, wherein the incoming message is an alphanumeric message.

33.(previously presented): The communication device of claim 20, wherein the incoming message is a voice mail message.

34.(previously presented): The method of claim 23, wherein the incoming message is a numeric message.

35.(previously presented): The method of claim 23, wherein the incoming message is an alphanumeric message.

36.(previously presented): The method of claim 23, wherein the incoming message is a voice mail message.

IX. EVIDENCE APPENDIX

No evidence has been submitted pursuant to §§ 1.130, 1.131, or 1.132 of this title nor any other evidence entered by the examiner and relied upon by appellant in the appeal.

X. RELATED PROCEEDINGS APPENDIX

Appellant is not aware of any appeals or interferences related to the present application.